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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

TRI4546P0170US

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on \_\_\_\_\_

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Application Number

10/685,750

Filed

Oct. 15, 2003

First Named Inventor

Mark Budzik

Art Unit

3673

Examiner

Gay Ann Spahn

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record. 24,103  
Registration number \_\_\_\_\_

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

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Nov. 2, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☒ Total of one forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**Attachment to Pre-Appeal  
Brief Request for Review  
Application No. 10/685,750**

The issues presented by the Office Action dated September 22, 2005, and discussed herein involve claims 1, 5, and 7, and their dependent claims, which are exemplified by claim 1, as follows:

1. A drywall-trimming accessory having a flange, which has two expansive surfaces facing oppositely, wherein the drywall-trimming accessory is made from a cellular polymer and wherein at least part of at least one of the expansive surfaces is characterized by open cells of the cellular polymer.

The patent examiner has contended that Koenig, Jr. *et al.* (US2002/013541 A1) discloses a drywall-trimming accessory made from a cellular polymer. As the patent examiner has noted, Koenig, Jr. *et al.* discloses a drywall-trimming strip, which is an example of a drywall-trimming accessory having a flange, and which is "extruded from a polymeric material, such as polyvinyl chloride." The patent examiner has noted in Hawley's Condensed Chemical Dictionary that "[f]lexible foams may be ... polyvinyl chloride ...."

The undersigned attorney submits that, although polyvinyl chloride is capable of being foamed, polyvinyl chloride is not foamed ordinarily, that a disclosure of polyvinyl chloride without any reference to its being foamed or its being cellular is not a disclosure of polyvinyl chloride being foamed or being cellular, and that it is improper hindsight to read into Koenig, Jr. *et al.* that its disclosure of polyvinyl chloride is a disclosure of a cellular polymer. The undersigned attorney does not submit, however, that the drywall-trimming strip of Koenig, Jr. *et al.* could not be made from a cellular polymer.

In any event, even if it were assumed *arguendo* that the disclosure of polyvinyl chloride in Koenig, Jr. *et al.* is a disclosure of a cellular polymer, the patent examiner has acknowledged that "Koenig, Jr. *et al.* fail to disclose claim 1's limitation that at least part of at least one of the expansive surfaces is characterized by open cells of the cellular polymer."

The patent examiner has referred to Hoffman, Sr. (US 6,684,586 B1) which also discloses a drywall-trimming strip, and which discloses in column 2, lines 19-22, that "the strip is perforated and knurled to increase the surface area and to facilitate the ability of construction adhesives and drywall compound to adhere to the surface of the strip."

The patent examiner has drawn a conclusion, which the undersigned attorney submits is an improper conclusion, that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the drywall-trimming accessory (strip 10) of Koenig, Jr. et al. by milling, abrading or otherwise roughening at least a part of at least one of the expansive surfaces of the flanges thereof and contacting the same part of the same one of the expansive surfaces of the flange thereof to a drywall-finishing compound as taught by Hoffman, Sr. in order to increase the surface area and this expose the open cells of the cellular polymer to the drywall compound so that the drywall trimming accessory would be better able to absorb the drywall compound."

The undersigned attorney submits that, even if it were assumed *arguendo* that Koenig, Jr. et al. disclosed a cellular polymer and that a surface of the drywall-trimming strip of Koenig, Jr. et al. would be perforated and knurled as taught by Hoffman, Sr., the record does not support a conclusion that the surface, so perforated and knurled, would be characterized by open cells of the cellular polymer. The undersigned attorney submits, rather, that perforations of a flange made from a cellular polymer would not be open cells of the cellular polymer and that the record does not reveal how perforating or knurling would affect a flange made from a cellular polymer.

Respectfully submitted,

By Allen J. Hoover  
Allen J. Hoover  
Reg. No. 24,103

November 2, 2005